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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/893,677

06/29/2001

Makoto Tomioka

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03/03/2008

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EXAMINER

CZEKAJ, DAVID J

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

03/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

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Ex parte: MAKOTO TOMIOKA and HIROSHI TSUYUKI

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Application 09/893,677

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on February 14, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

Appellants' Appeal Brief filed March 27, 2007, states on page 2, under the heading *Status of Claims* that "[p]ending claims 1-18 stand rejected. Claim 19 has been cancelled. No claims have been allowed or objected to. The claims on appeal are claims 1-18." Under the *Grounds of Rejection to be Reviewed on Appeal* heading on page 4 states:

The rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The rejection of claims 1 and 3-19<sup>[1]</sup> under 35 U.S.C. § 103(a) as being unpatentable over Igarashi (U.S. Patent No. 5,902,232) in view of Takahashi (US Patent No. 5,588,948).

The rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Igarashi (U.S. Patent No. 5,902,232) in view of Takahashi (US Patent No. 5,588,948) and Igarashi (U.S. Patent No. 5,954,634).

The Examiner's Answer mailed July 26, 2007, on page 2 under the heading "Status of Claims" states that "The statement of the status of claims contained in the brief is correct." However, the Examiner did not include the rejection of claim 1 under 35 U.S.C. § 112, first paragraph in the section entitled "Grounds of Rejection." The examiner's Answer is also silent as to whether this ground of rejection has been withdrawn.

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<sup>10</sup> Page 2 of the Appeal Brief indicates that this appeal involves only claims 1-18. Claim 19 was cancelled in an amendment filed on October 4, 2006.

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Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed July 26, 2007, and issue a revised Examiner's Answer with clarification of the status of the rejection of claim 1 under 35 U.S.C. § 112, first paragraph; and
- 2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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